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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,062	12/23/1999	TADASHI OHASHI	1341.1037/JD	8272
21171	7590	05/21/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/472,062

Applicant(s)

OHASHI, TADASHI

Examiner

Maikhanh Nguyen

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communications: RCE filed 02/27/2004 to the original application filed 12/23/1999.
2. Claims 1-11 are currently pending in this application. Claims 1, 6 and 9 are independent claims.

***Request Continuation for Examination***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/25/2004 has been entered.

***Election/Restrictions***

4. Newly submitted claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
  - Claims 1-11, drawn to an integrated document management system for retrieving both the document in the upper layer and the document in the lower layer, classified in class 715, subclass 514.

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- Claim 12 drawn to a document retrieval method for retrieving component documents of the master document, classified in class 715, subclass 500.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Serbinis et al.** (U.S. 6,584,466 – filed 04/1999) in view of **Usdin et al.** “XML: Not a Silver Bullet, But a Great Pipe Wrench”, 09/1998.

**As to independent claim 1**, Serbinis discloses an integrated document management system (*document management system; col.3, lines 14-19*) comprising:

- a storage unit (*store 30 preferably comprises either a relational database, where the electronic documents and information about the document is stored in the relational database; col.5, lines 47-62*) which stores therein a document database (*database; col.5, lines 27-62*) comprising plurality of documents having together a hierarchical structure (*hierarchical storage scheme for storing electronic documents; col.7, lines 16-22*)

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comprising an upper layer and lower layer (*hierarchical storage scheme for storing electronic documents ... a generalized high level description of a document ...DMS system 17 also preferable supports multiple versions of documents ...the parent and child document instance, a version name and a unique version ID; col.7, lines 17-62 & Fig.3*),where the structure is defined with hypertext described in an extended markup language (*XML; col.16, lines 1-25*);

- a server (*store 30 is connected to server computer; col.5, lines 36-47 & Figs. 1A-B*) connected to said storage unit and provided with the manager of the documents (*server 20 provides digital certificates to users ...sign document; col.6, lines 1-7*); and

- a client connected via a network to said server (*one or more separate computers connected to server computer; col.5, lines 63-67*) and retrieves, based on the management information, by accessing said server (*an electronic document may be stored on an Internet-accessible server and accessed ...the server for access ... including storage and retrieval service; Abstract*), the document in the upper layer and the document in the lower layer each having a specified version number from the document database (*DMS system 17 also preferably supports multiple versions of documents ... A document version object is employed in document information table of database; col.7, lines 42-48*).

Serbinis does not explicitly disclose “an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer, a document type definition file describing information on a version number of each document, and a document style sheet file define a style of each document.”

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Usdin discloses an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer (*XML assumes that data are hierarchically structured ... which consist of name 'root' element which begins at the beginning of the document ... The hierarchical structure is fairly obvious in text documents ... a section starts ... the same level ... A section ... subsections; page 126*), a document type definition file describing information on a version number of each document (*Document Type Definition ... specify what the root element is for a document type ... define the contents of elements ... define relationships among the contents of various elements; page 127; right column – page 128, left column*), and a document style sheet file define a style of each document (*The language for stylesheets for XML documents; page 128, right column*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Usdin in the system of Serbinis because Usdin's teaching would have provided the capability for identifying all of the types of information that are needed for searching, retrieving, formatting, and tracking.

**As to dependent claim 2**, Serbinis discloses the management information includes information indicating a collection of a plurality of documents in a on the same layer (*Document objects 72A and 72B represent a generalized high level description of a document; col.7, lines 28-32*) and version number of the plurality of documents, and said client retrieves, based on the management information, by accessing from said server the collection of the plurality of documents in the same layer, the documents retrieved each having a specified version number, from the document database (*hierarchical storage scheme for storing electronic documents ... a generalized high level description of a*

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*document ...DMS system 17 also preferable supports multiple versions of documents ...the parent and child document instance, a version name and a unique version ID; col.7, lines 17-62 & Fig.3).*

**As to dependent claim 5**, Serbinis discloses the management information includes information concerning a security level corresponding to each of the plurality of documents and said server permits or inhibits retrieval of the document according the security level (*col.7, lines 8-62 & Abstract & Fig.2*).

**As to independent claim 6**, it is directed to a document retrieve device for performing the system of claim 1, and is similarly rejected under the same rationale.

**As to dependent claim 8**, it includes the same limitations as in claim 5, and is similarly rejected under the same rationale.

**As to independent claim 9**, it is directed to a computer-readable recording medium for implementing the system of claim 1, and is similarly rejected under the same rationale.

**As to dependent claim 7 & 10**, they include the same limitations as in claim 2, and are similarly rejected under the same rationale.

**As to dependent claim 11**, it includes the same limitations as in claim 5, and is similarly rejected under the same rationale.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Serbinis et al.** in view of **Usdin et al.** as applied to claim 1 above, and further in view of **Hashimoto et al.** (U.S. 5,893,114 – filed 11/1996).

**As to dependent claim 3**, the combination of Serbinis and Usdin does not explicitly disclose “the server registers, when a document registered in the document

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database is updated, the updated document in the document database, and also updates the version number information in the management information concerning the document.”

Hashimoto discloses the server registers, when a document registered in the document database is updated, the updated document in the document database, and also updates the version number information in the management information concerning the document (*the document once registered ... the document is periodically updated; col.5, lines 15-52 & Fig.12*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hashimoto’s teaching in the system of Serbinis as modified by Usdin because Hashimoto’s teaching would have provided the enhanced capability for automatically storing a referred electronic document in a database and notifying new information to a user.

**As to dependent claim 4**, Serbinis discloses said client sends via the network to said server retrieval information for a document that has been retrieved (*Fig. 1B*).

The combination of Serbinis and Usdin does not explicitly disclose “said server sends, when a document corresponding to the retrieval information is updated, updating information related to the document updated.”

Hashimoto discloses said server sends, when a document corresponding to the retrieval information is updated, updating information concerning the updated document via the network to said client (*server is always accessed to acquire the latest document data; col.5, lines 36-45*).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hashimoto's teaching in the system of Serbinis as modified by Usdin because Hashimoto's teaching would have provided the enhanced capability for automatically storing a referred electronic document in a database and notifying new information to a user.

### ***Response to Arguments***

7. Applicants' arguments filed 03/25/2004 have been considered but they are not persuasive.

Applicant argues that *Serbinis does not disclose how its hierarchy of document objects, instances, and groups are defined.* (Remarks, page 7)

In response, Usdin (the newly applied prior art) is combined with Serbinis to teach the features as amended by Applicant (XML assumes that data are hierarchically structured ... which consist of name 'root' element which begins at the beginning of the document ... The hierarchical structure is fairly obvious in text documents ... a section starts ... the same level ... A section ... subsections; Usdin, page 126).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-

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0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
May 13, 2004

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER